

### **Remarks**

Reconsideration of the application is respectfully requested in view of the foregoing amendments and following remarks. Claims 1-6, 8-15, 32-36, and 38-44 are pending in the application. No claims have been allowed. Claims 1, 6, 11 and 32 are independent. Claims 1, 6, 8-11, 32, 36, 38, and 44 have been amended.

### **§ 101 Rejections**

The Action rejects claims 1-6, 8-15, 32-36, and 38-44 under 35 U.S.C. § 101 as being directed to non-statutory subject matter.

The Supreme Court has interpreted § 101 broadly, “[a]s the Supreme Court has recognized, Congress chose the expansive language of 35 U.S.C. 101 so as to include ‘anything under the sun that is made by man’ as statutory subject matter. *Diamond v. Chakrabarty*, 447 U.S. 303, 308-09, 206 USPQ 193, 197 (1980).” MPEP § 2106(IV)(A). “Accordingly, a complete definition of the scope of 35 U.S.C. 101, reflecting Congressional intent, is that any new and useful process, machine, manufacture or composition of matter under the sun that is made by man is the proper subject matter of a patent.” MPEP § 2106(IV)(A).

According to a later case, “[t]he claimed invention as a whole must be useful and accomplish a practical application. That is, it must produce a ‘useful, concrete and tangible result.’ *State Street*, 149 F.3d at 1373, 47 USPQ2d at 1601-02.” MPEP § 2106(II)(A).

### **Claims 6, 8-10, 32, 36, and 38**

The Action rejects claims 6, 8-10, 32, 36 and 38 under 35 U.S.C. § 101 as being directed to non-statutory subject matter. Applicants respectfully disagree, but in order to expedite prosecution, have amended the claims as outlined below.

Applicants have amended claim 6 to recite “A *tangible computer-readable medium* storing computer-executable instructions thereon for instructing a computing device to store an album of images to a removable digital storage medium... .” As stated in the USPTO “Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility,” signed October 26, 2006, at

Annex IV(a), “In contrast, a claimed computer-readable medium encoded with a computer program is a computer element which defines a structural and functional interrelationship between the computer program and the rest of the computer which permit the computer program’s functionality to be realized, *and is thus statutory.*” (emphasis added).

Furthermore, when the functionality of claim 6 is realized, claim 6 accomplishes a practical application, for example, saving image files on a removable storage medium. Claim 6 also produces a useful, concrete, and tangible result. For example, claim 6 recites, “save, to the removable digital storage medium, the one or more compressed image file copies that correspond to the selected images, wherein the album of images is saved on the removable storage medium in a format readable by a media reader in the stand-alone set-top box to display the selected images on the television.”

Because claim 6 and dependent claims 8-10, 36, and 38 are directed to statutory subject matter, Applicants request that the § 101 rejection of claims 6, 8-10, 36, and 38 be withdrawn.

Applicants have amended claim 32 to recite, “A *tangible computer-readable medium* storing computer-executable instructions thereon for instructing a computing device to store an album of images on a removable storage device for transfer to a television-set-top box for display on a television... .” In addition, claim 32 recites, “save, to the removable storage medium, the one or more compressed image file copies that correspond to the selected images, wherein the album of images saved to the removable storage medium is readable by a media reader in the set-top box to display the selected images on the television.” For at least the reasons stated above with regard to claim 6, claim 32 is directed to statutory subject matter. Applicants request that the § 101 rejection of claim 32 be withdrawn.

### **Claims 1-5, 33-35, and 42-44**

The Action rejects claims 1-5, 33-35, and 42-44 under 35 U.S.C. § 101 as being directed to non-statutory subject matter. Specifically, the Examiner states that these claims recite “functional descriptive material on a computer readable medium” and are not limited to a practical application. Action, page 4.

Claim 1 clearly accomplishes a practical application, for example, storing a collection of digital images on a removable storage medium. Claim 1 also produces a useful, concrete, and tangible result. For example, claim 1 recites, “*saving*, to the removable storage medium, the album of images

comprising the compressed image file copies that correspond to the selected images wherein the album of images is transferable via the removable storage medium to a media reader in the set-top box to display the selected images on the television.” Furthermore, claim 1 produces a real-world result, for example, saving the album of images on the removable storage medium.

Because claim 1 has a practical application and produces a useful, concrete, and tangible result, claim 1, and dependent claims 2-5, 33-35, and 42-44, should not be subject to a § 101 rejection.

### **§ 112 Rejections**

Claim 44 is rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement, and under § 112, second paragraph, as being indefinite. Applicants respectfully disagree. However, in order to expedite prosecution, Applicants have amended claim 44 to remove the language objected to by the Examiner. Claim 44 therefore should not be subject to a § 112 first or second paragraph rejection.

### **Claim Objection**

The Examiner objects to the term “carrier” in claim 6. Applicants have amended claim 6 to remove the term “carrier.”

### **§ 103(a) Rejections**

Claims 1-6, 8-15, 32-36, and 38-44 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Geigel et al., U.S. Patent Application No. 2002/0122067 (Geigel), in view of Washino et al., U.S. Reissue Patent No. RE38,079 (Washino) and Schwab et al., U.S. Patent Application No. 2004/0250083 (Schwab).

### **Claims 1-6, 8-15, 32-36, and 38-44**

Amended claim 1 reads as follows (emphasis added):

A method of storing a collection of digital images on a removable storage medium, the removable storage medium usable for transferring the stored digital images to a set-top box coupled to a television, the method comprising the steps of:

...

c) prompting the user to select a plurality of images from the group;

...

j) *saving, to the removable storage medium, the album of images comprising the compressed image file copies that correspond to the selected images wherein the album of images is transferable via the removable storage medium to a media reader in the set-top box to display the selected images on the television.*

Amended claim 6 reads as follows (emphasis added):

A tangible computer-readable medium storing computer-executable instructions thereon for instructing a computing device to store an album of images to a removable digital storage medium, the removable digital storage medium usable to transfer the stored album of images to *a stand-alone set-top box coupled to a television*, the stand-alone set-top box designed to display the album of digital images on the television, the computer-executable instructions comprising instructions to:

...

c) *prompt the user to select a plurality of images from the group;*

...

j) *save, to the removable digital storage medium, the one or more compressed image file copies that correspond to the selected images, wherein the album of images is saved on the removable storage medium in a format readable by a media reader in the stand-alone set-top box to display the selected images on the television.*

Amended claim 11 reads as follows (emphasis added):

An apparatus for the creation of a digital photo album, the apparatus creating and saving the digital photo album to a removable storage medium, the removable storage medium being usable to transfer the digital photo album to *a set-top box coupled to a television*, the set-top box usable to display the digital photo album on the television, the apparatus comprising:

...

c) *means for prompting the user to select a plurality of images from the group;*

...

j) *means for saving, to the removable storage medium, the digital photo album comprising the compressed image file copies that correspond to the selected images, wherein the digital photo album is saved on the removable storage medium in a format for transferring to a media reader in the set-top box to display the selected images on the television.*

Amended claim 32 reads as follows (emphasis added):

A tangible computer-readable medium storing computer-executable instructions thereon for instructing a computing device to store an album of images on a removable storage device for transfer to *a television-set-top box* for display on a television, the computer-executable instructions comprising instructions to:

...

- c) *prompt the user to select a plurality of images from the group;*  
...  
j) *save, to the removable storage medium, the one or more compressed image file copies that correspond to the selected images, wherein the album of images saved to the removable storage medium is readable by a media reader in the set-top box to display the selected images on the television;*

Support for the above amendments can be found, for example, throughout the specification. For example, a “software application” (¶¶ [0028], [0057]) creates digital photo albums and stores the albums (¶ [0033]) on a “removable media such as a standard 3.5 inch Floppy Disk” (¶¶ [0031], [0055]; Figure 2, step 32) or “other recordable medium such as a CD, ZIP drive, ... network drive, flash memory.” (¶ [0032].) “*As a result, the images, having been reduced in size for TV ... may be stored on a small, inexpensive, removable media such as a standard 3.5 inch Floppy Disk.*” (¶ [0031], emphasis added.) “After creating a stored photo album, in a preferred embodiment a small TV set-top box is used to display the images on a TV.” (¶¶ [0035], [0058]; Figure 1.) The set-top box includes “a media reader (a floppy disk drive ...) to read the digital photo album images.” (¶ [0036]; Figure 1, item 10, Figure 9, item 92.) The set-top box “contains hardware, software, and preferably firmware that transform JPG digital images into TV signals.” (¶ [0036].)

The Examiner argues that Geigel teaches “prompting the user to select a plurality of images from the group” as recited by claim 1, and the similar above-cited language of claims 6, 11, and 32, respectively. Applicants respectfully assert that Geigel does not teach or suggest this language. The Examiner cites to Geigel’s description of “user preferences” at [0010]. Geigel describes an “Automated Albuming System” that automatically produces albums using genetic algorithms. Geigel at [0065] and [0066]. Regarding “user preferences,” Geigel describes that the user preferences are album layout preferences related to general principles such as balance, spacing, chronology, etc. Geigel at [0079]-[0085]. For example, Geigel describes a user preference of 1.0 for white space, indicating that a larger amount of white space is desired around images. Geigel at [0086]. Geigel’s description of general layout preferences does not teach or suggest “prompting the user to select a plurality of images from the group” as recited by claim 1, or the similar above-cited language of claims 6, 11, and 32, respectively. In addition, as understood by Applicants, Schwab and/or Washino, separately or in combination with Geigel, do not teach or suggest this language.

The Examiner acknowledges that Geigel does not teach “saving, to the removable storage

medium, the album of images comprising the compressed image file copies that correspond to the selected images wherein the album of images is transferable via the removable storage medium to a media reader in the set-top box to display the selected images on the television” as recited by claim 1, or the similar above-cited language of claims 6, 11, and 32, respectively. Instead, the Examiner argues that Washino teaches this language. Action, pages 8-9.

Applicants respectfully assert that Washino fails to teach or suggest “saving, to the removable storage medium, the album of images comprising the compressed image file copies that correspond to the selected images wherein the album of images is transferable via the removable storage medium to a media reader in the set-top box to display the selected images on the television” as recited by claim 1, or the similar above-cited language of claims 6, 11, and 32, respectively.

The Examiner argues that Washino (at 4:45-50) describes “saving, to the removable storage medium, the album of images comprising the compressed image file copies that correspond to the selected images” as recited by claim 1. However, this section of Washino only describes recording images on media (e.g., removable hard-disk drives) in general. This section of Washino does not describe saving an “album of images” or that the album of images comprises “image file copies that correspond to the selected images.”

The Examiner also argues that Washino (at Fig. 7 blocks 218, 220, 234, or 242) describes “wherein the album of images is transferable via the removable storage medium to a media reader in the set-top box” as recited by claim 1. Action, page 9. The Examiner further argues that Washino describes a set-top box, citing element 242 in Fig. 7. Action, page 15. Applicants respectfully disagree. Fig. 7 of Washino, and the related description, describes an embodiment of a video production system including various components such as a microprocessor (228), RAM (230), storage (236, 238, 240), and a graphics processor (242). The digital tuner (218) and data network adapter (220) are described as receiving signals (e.g., broadcast and satellite signals). The hard disk drive controller (234) “provides access to various storage means.” (13:26 to 14:17.) The graphics processor (242) “performs the image manipulations required to convert between the various frame sizes (in pixels), aspect ratios, and frame rates.” (13:52-56.) Washino never teaches or suggests that the graphics processor (242), or the other elements of Figure 7, can be in a set-top box coupled to a television, as recited in claims 1, 6 and 11, respectively, or in a television set-top box as recited in claim 32. Furthermore, Washino never teaches or suggests that the graphics processor (242), or the other elements of Figure 7, can be used to display

selected images from an album of images stored on a removable storage medium on a television, as recited in claims 1, 6, 11 and 32, respectively.

The Examiner argues that Washino (at 17:30-32) describes “to display the selected images on the television” as recited by claim 1. However, this section of Washino describes, “accessing the program in the production format from the high-capacity storage [means] *medium*.” It does not teach or suggest “to display the selected images on the television” as recited by claim 1.

In addition, as understood by Applicants, Schwab, separately or in combination with Geigel and/or Washino, does not teach or suggest the above-cited language of claims 1, 6, 11, and 32, respectively.

For at least these reasons, claims 1, 6, 11, and 32, and their dependent claims 2-5, 8-10, 12-15, 33-36, and 38-44, should be allowable. Such action is respectfully requested. In view of the foregoing discussion, the Applicants will not belabor the merits of the separate patentability of the dependent claims.

### **Request for Interview**

If any issues remain, the Examiner is formally requested to contact the undersigned attorney prior to issuance of the next Office action in order to arrange a telephonic interview. It is believed that a brief discussion of the merits of the present application may expedite prosecution. Applicants submit the foregoing formal Amendment so that the Examiner may fully evaluate Applicants’ position, thereby enabling the interview to be more focused.

This request is being submitted under MPEP § 713.01, which indicates that an interview may be arranged in advance by a written request.

### Conclusion

The claims should be allowable. Such action is respectfully requested.

Respectfully submitted,

KLARQUIST SPARKMAN, LLP

One World Trade Center, Suite 1600  
121 S.W. Salmon Street  
Portland, Oregon 97204  
Telephone: (503) 595-5300  
Facsimile: (503) 595-5301

By /Cory A. Jones/  
Cory A. Jones  
Registration No. 55,307